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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/470,582	12/22/1999	STEVEN B. SOLOMON	067251.0105	6338

7590

04/28/2003

BAKER & BOTTS
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EXAMINER

MYHRE, JAMES W

ART UNIT PAPER NUMBER

3622

DATE MAILED: 04/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/470,582

Applicant(s)
Solomon et al

Examiner
James W. Myhre

Art Unit
3622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 25, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-14, 16-26, 28-32, and 34-38 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-14, 16-26, 28-32, and 34-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

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DETAILED ACTION

Response to Appeal Brief

1. In view of the Appeal Brief filed on November 25, 2002, PROSECUTION IS HEREBY REOPENED. New grounds for rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section

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122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. Claims 1, 2, 4-14, 16-26, 28-32, and 34-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Quinlan et al (US2002/0161641).

Claims 1, 8, 9, 12, 20, 21, 24, 32, and 36: Quinlan discloses a system, apparatus, and method for processing rebates, comprising:

- a. A promotion database describing various rebate offers received from sponsors (page 6, paragraph 0045; page 11, paragraph 0070-0073; and page 14, paragraph 0094);
- b. A transaction database describing purchases made by customers of one or more merchants (page 6, paragraphs 0043-0044 and page 11, paragraphs 0070-0073);
- c. Receiving rebate a rebate request from a customer, the request including at least the customer's identity, the identity of the product for which the rebate is requested, and the identity of the corresponding transaction (e.g. customer name and address/account number, the UPC code for the rebated product, and the transaction/receipt number of the corresponding purchase)(page 6, paragraphs 0045-0046 and page 11, paragraph 0070-0073);
- d. Providing a status report of a rebate to the customer (page 12, paragraph 0079); and
- e. Generating promotion reports for the sponsors (page 12, paragraph 0081).

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Claims 2, 16, and 28: Quinlan discloses a system, apparatus, and method for processing rebates as in Claims 1, 8, and 20 above, and further discloses a plurality of rebate payment options available to the customer (page 11, paragraph 0073).

Claims 4, 11, and 23: Quinlan discloses a system, apparatus, and method for processing rebates as in Claims 1, 8, and 21 above, and further discloses allowing the customer to mail in the request form (page 8, paragraphs 0054-0055 and page 11, paragraph 0074).

Claims 5, 13, 25, and 38: Quinlan discloses a system, apparatus, and method for processing rebates as in Claims 1, 8, 24, and 32 above, and further discloses the promotion reports includes all pertinent information about the rebate program, such as number of rebates, breakage rate, name and addresses of requestors, etc. (page 12, paragraph 81).

Claim 6: Quinlan discloses a system for processing rebates as in Claim 1 above, and further discloses the customer receiving a status report on a submitted rebate request (page 12, paragraph 0079).

Claims 7, 14, and 26: Quinlan discloses a system, apparatus, and method for processing rebates as in Claims 1, 8, and 20 above, and further discloses receiving, after verification/approval of the rebate request, authorization with selectable disbursement options (page 11, paragraph 0073).

Claims 10, 22, and 37: Quinlan discloses a system, apparatus, and method for processing rebates as in Claims 9, 21, and 36 above, and further discloses receiving the information over a network, such as the Internet (page 5, paragraphs 0037 and 0041 and page 6, paragraph 0043).

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Claims 17, 29, and 34: Quinlan discloses a system, apparatus, and method for processing rebates as in Claims 16, 28, and 33 above, and further discloses the disbursement options comprise a cash rebate and a credit voucher ("certificate for redemption only at a participating member of the retail network")(page 5, paragraph 0036 and page 6, paragraph 0047).

Claims 18, 30, and 35: Quinlan discloses a system, apparatus, and method for processing rebates as in Claims 16, 20, and 32 above, and further discloses the promotion including a product identifier, an end date for the promotion, and a geographic target for the promotion (page 5, paragraph 0038 and page 9, paragraph 0061).

Claims 19 and 31: Quinlan discloses a method and apparatus for processing rebates as in Claims 8 and 20 above, and further discloses the transaction information including personal information of the purchaser and the purchase information (page 6, paragraphs 0042-0044).

Response to Arguments

4. Applicant's arguments with respect to claims 1, 2, 4-14, 16-26, 28-32, and 34-38 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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A. Holda-Fleck (5,729,693) discloses a system and method for processing electronic rebates through a central processing center which maintains databases of rebate offers from manufacturers and personal files for each customer.

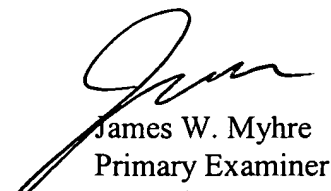
B. Freeman et al (6,450,407) discloses a system for processing rebates using a chip card. The rebate offer data and the transaction data are forwarded over the Internet to a centralized rebate processing point which compares a customer's rebate request with the transaction and offer data to verify authenticity and process the request.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9326. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.


JWM
April 23, 2003


James W. Myhre
Primary Examiner
Art Unit 3622